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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,009	06/03/2005	Zvi Feldman	053332-5005	6860
9629 7590 12/12/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER REESE, DAVID C	
			ART UNIT 3677	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,009	Applicant(s) FELDMAN ET AL.	
	Examiner David C. Reese	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 13, 18-21, 23-26, 30, 32, 33, 35-44 and 47-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-12, 14-17, 22, 27, 31, 34, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

- Claims 3-4, 13, 18-21, 23-26, 38-30, 32-33, 35-44, and 47-51 are withdrawn (see below).
- Claims 1-51 are pending.

Election/Restrictions

[1] Claims 3-4, 13, 18-21, 23-26, 38-30, 32-33, 35-44, and 47-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant's election without traverse of Claims 1-51 in the reply filed on 9-24/2007 is acknowledged.

Claim Rejections - 35 USC § 112

[2] The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[3] Claims 1-2, 5-12, 14-17, 22, 27, 31, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the instant set of claims it is unclear as to which member is considered the 'fastener'. For example, in claim 5 it is stated that the fastener comprises a lens-face engaging member having a lower and a top surface adapted to engage said head. Claim 5, however, is dependent from claim 2, where a fastener is claimed having a head

and a stem. It is apparent to the examiner that the fastener from claim 5 is referring to the 'ring' (40) while the fastener from claim 2 is depicting a screw. It is apparent to the examiner that clarification and/or claim amendments may be necessary to properly delineate the correct structural limitations of the fastener depending on whether it is a screw or the ring 40. Please also note that solely further withdrawing claim 2 will not remedy the situation since claim 5 is dependent upon claim 2. Please also see the connection of claim 10 to claims 5 and 2; and in addition, the examiner asks the applicant's cooperation in maintaining that the issue above is resolved for any remaining dependent claims where said issue arises.

Appropriate correction is required.

[4] Claim 8 recites the limitation "the edge" in the instant claim. There is insufficient antecedent basis for this limitation in the claim or dependent one therefrom.

Claim Rejections - 35 USC § 102

[5] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[6] Claims 1-2, 5-12, 14-17, 22, 27, 31, 34, 45, 46 are rejected under 35 U.S.C. 102(b) as anticipated by Yoshida, US-6,170,950, because the invention was patented or described in a

printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Yoshida is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Yoshida discloses of a fastening arrangement (see figure 14) for use with a curved lens (12) having a first face, a second face and a bore passing between them and having a longitudinal axis slanted to the lens's faces, for attaching to said lens (12) a component (16) at the first face of the lens; the fastening arrangement comprising a fastener (68 or 18 (note wherever 'or' is used is due to the ambiguity regarding the fastener as raised in the 112 rejections above)) having a lens-face engaging portion (72 or 30) adapted to engage the second face of the lens and a component engaging portion (70 or 28) entering the bore at said second face; said fastening arrangement further comprising a fastener engaging portion (24) in said component (16) adapted to engage said component engaging portion (70 or 28) of the fastener (68 or 28); all the engaging portions being designed so that, when the component (16) and the lens (12) are assembled, the lens-face engaging portion (72 or 30) is oriented along said second face of the lens (12).

Re: Claim 2, wherein said fastener (18) has a head (30) and a stem (28) with a longitudinal axis, said stem (28) constituting said component engaging portion.

Re: Claim 5, wherein said fastener (68) comprises a lens-face engaging member (72) having a lower surface (bottom of 72) that constitutes a lens-face engaging surface and a top

surface (top of 72) adapted to engage said head (30), said member (68) having a through bore coaxial with said bore of the lens (12).

Re: Claim 6, wherein said lower surface (bottom of 72) is slanted with respect to said longitudinal axis of the stem so as to be oriented along said second face of the lens (12) when the lens (12) and the component (16) are assembled.

Re: Claim 7, wherein the lens-face engaging member (72) comprises means to facilitate fixing its position relative to the lens (12).

Re: Claim 8, wherein said means is in the form of a projection (70) and said component (16) is L-shaped and has a ledge formed with said fastener engaging portion (24) and a leg to support the lens's edge, said means interfacing (via 24) said leg.

Re: Claim 9, wherein said means (70) is in the form of a projection interfacing with the lens (12).

Re: Claim 10, wherein said lens-face engaging member (72) has a recess in its top surface formed around said through bore and a shoulder (see directly below 30-the ledge supporting the head of the fastener) in said recess surrounding said bore, with which said head (30) of the fastener (18) interfaces.

Re: Claim 11, wherein the shoulder (see directly below 30-the ledge supporting the head of the fastener) is designed such that the longitudinal axis of the stem is parallel to that of the bore.

Re: Claim 12, wherein said recess has a depth greater than the height of the fastener's (18) head (30).

Re: Claim 14, wherein the component engaging portion (70) has a longitudinal axis parallel to the longitudinal axis of the bore.

Re: Claim 15, wherein said component (16) is formed with a plug received within said bore, said plug being formed with a cavity (26) constituting said fastener engaging portion (24) having a longitudinal axis.

Re: Claim 16, wherein said longitudinal axis is slanted with respect to the second lens face.

Re: Claim 17, wherein the component engaging portion (28) of the fastener (18) connects to the fastener engaging portion (24) of the component in a male-to-female configuration, respectively.

Re: Claim 22, wherein the lens (12) has an edge and the component (16) is L-shaped and has a ledge formed with said fastener engaging portion (24) and a leg having a lens-edge interfacing portion.

Re: Claim 27, wherein said component engaging portion (28) of the fastener (18) and the fastener engaging portion (24) of the component (16) are interengageable in a threaded fashion.

Re: Claim 31, wherein the component (16) is a clip of an eyeglass clip-on.

As for Claim 34, Yoshida discloses of an eyeglass assembly comprising a component, a lens and a fastening arrangement as described in claim 1.

As for Claim 45, Yoshida discloses of a component (16) designed for attached to a curved lens (12) having a first face, a second face and a bore passing between them and having a longitudinal axis slanted to the lens's faces; the component (16) comprising a fastener engaging portion (24) designed for inter-engaging with a fastener (18) entering the bore at said first face,

the fastener engagement portion (24) being designed for entering the bore at said second face and having a longitudinal axis normal to the first face so that, when the component (16) and the lens (12) are attached, the fastener (18) has an interface oriented along the first face of the lens.

As for Claim 46, Yoshida discloses component (16) designed for attaching to a curved lens (12) having a first face, a second face and a bore passing between them and having a longitudinal axis slanted to the lens's faces; the component (16) comprising a fastener engaging portion (24) designed for inter-engaging with a fastener (18) entering the bore at said first face and aligning the fastener (18) with the bore; the component further comprising a first (23a) and second (24) lens-face engaging portions engageable respectively with said first and second faces so that, when the component (16) and the lens (12) are attached, the lens-face engaging portions (23a, 24) are oriented along the first and second faces of the lens (12).

Conclusion

[7] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of fastening system; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see submitted notice of reference cited.

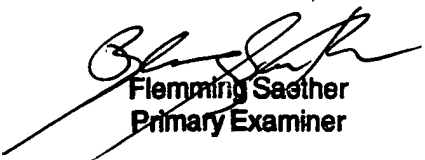
[8] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached at (571) 272-7069. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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DCR



Flemming Sæther
Primary Examiner